

REMARKS

Applicant has amended Claim 3 and canceled Claims 1-2, 4, 7, 9 and 11. Claims 3, 5-6, 8, 10 and 12 are pending. A one month extension of time petition is included to allow a timely response in this matter by October 10, 2006 (October 7th is a Saturday and October 9th is a federal holiday). A request for continued examination (RCE) is included to stay the finality of the office action. No new matter has been added.

Claim Rejections – 35 U.S.C. § 102

Based on the Advisory Action, the rejections based on Chen et al. (U.S. 6,773,102) and Wang et al. (U.S. 2004/0063807) have been overcome.

Claims 1, 3, and 6-10 stand rejected under 35 U.S.C. § 102(b) for anticipation by Patel et al. (U.S. 5,977,210) taken in view of the evidence given in Sasaki et al. (U.S. 4,248,636) and Satake et al. (U.S. 5,814,685). Applicant respectfully disagrees. Applicant has canceled Claims 1-2, 4, 7, 9 and 11. Claim 3 is amended to place the surfactant element in a proper Markush format and clarify that the surfactant element is limited to anionic surfactants, nonionic surfactants or mixtures thereof, but excludes cationic surfactants.

In the Advisory Action, the Examiner states that MPEP 2111.03 states that the transitional term “comprising,” results in an inclusive or open-ended claim, even where an element of the claim uses Markush-type language. Case law is contrary to this view. Abbott Laboratories v. Baxter Pharmaceutical Products, Inc., 334 F.3d 1274 (Fed. Cir. 2003), stands for the proposition that the use of Markush-type language in a claim element where the preamble uses the transitional phrase “comprising,” closes the group of alternatives for that particular element, not the entire claim. Abbott was explained in Maxma v. Conocophillips, Inc., 2005 U.S. Dist. LEXIS 34020 (Jul 19, 2005 U.S. Dist. E. TX) as follows:

The Markush group in [*Abbott*] required the presence of an “amount effective” of a Lewis acid inhibitor selected from a group. *Abbott Laboratories*, 334 F.3d at 1276. The patentee attempted to prove infringement by combining two Lewis acid inhibitors to prove that the combination of those substances in the accused product was an “amount effective.” *Id.* at 1282-1283. The Federal Circuit noted, however, that the Markush group at issue did not permit mixtures of the individual members of the group. *Id.* at 1283. Therefore, the court concluded that the patentee, to prove literal infringement, would need to show that only one member of the group was present in an “amount effective” to meet the claim limitation. *Id.* at 1282. “Thus, the plain meaning of asserted claims 1 and 6 limits them to a single Lewis acid inhibitor selected from the recited Markush

group, and present in an amount effective to prevent degradation of sevoflurane by Lewis acids.”
Id. at 1281.

In Abbott, as to Lewis Acids, the claim was closed to the Markush group, which did not permit mixtures of the individual members of the group. The claim was open in all other respects because of the transitional phrase “comprising,” but closed with respect to the Markush-type language used for Lewis Acids. The Abbott decision also cites at page 1281, Mannesmann Demag Corp. v. Engineered Metal Prods. Co., 793 F.2d 1279, 1282 (Fed. Cir. 1986) as “confirming that the phrase ‘consisting of’ appearing in a clause of a claim specifically limits only the element set forth in that clause”.

Patel et al. teaches the aggregation of pigments and polymers requiring the use of cationic surfactants to accomplish agglomeration. (Column 3, line 26-36 and 46-47, and also Figure 1). Claims 1 and 3 cover the use of anionic or nonionic surfactants only. The Examiner’s rejection in paragraph 5 of the office action mailed 11/28/05 erroneously states that anionic or cationic surfactants are described in Patel et al. In fact, an anionic surfactant is always coupled with a cationic surfactant (Column 3, lines 28, 47, 54 and 62). To do otherwise would render Patel et al. non-functional because the cationic surfactant is necessary to accomplish agglomeration.

Applicant maintains that the present reading of “comprising” is inconsistent with established case law and that the present claim is not open to the inclusion of cationic surfactants, and therefore is not anticipated by the reference.

Moreover, Patel et al. fails to teach what, if any, water-soluble surface agents are needed to adhere to hydrophobic surfaces as opposed to other surfaces and what Tg levels to select for the aqueous emulsion polymer for the method of providing an image on a hydrophobic surface. Patel et al. fails to disclose each and every element of the claimed invention, arranged as in the claim.

Claims 1, 3, and 6-12 stand rejected under 35 U.S.C. § 102(b) for anticipation by Cheng et al. (U.S. 6,239,193) taken in view of the evidence given in Milne (U.S. 4,849,286). Applicant respectfully disagrees. Applicant has canceled Claims 1-2, 4, 7, 9 and 11. Claim 3 is amended to place the surfactant element in a proper Markush format and clarify that the surfactant element is limited to anionic surfactants, nonionic surfactants or mixtures thereof, but excludes cationic surfactants.

Cheng et al. does not disclose a method for providing an image on a hydrophobic surface. The transparency material disclosed in Cheng et al. is a “transparency material suitable for aqueous ink jet inks or ink jet printing” (col. 15, lines 33-38). The term “suitable for aqueous ink jet inks or ink jet printing” means a coated substrate which has been treated to accept an aqueous ink jet ink. Transparency substrates for inkjet ink printing are typically coated substrates, which is the advantage of the present invention. As stated in paragraph 2 (emphasis added), “This

invention particularly relates to an aqueous inkjet ink composition suitable for printing a durable image on the surface of a hydrophobic substrate without the need for additional processing such as, for example, lamination, pretreatment of the surface, and the application of an overprint varnish or other coating."

The Examiner cited Milne as proof of the hydrophobic nature of the transparency recited in Cheng et al. When the Applicant identified that Milne is a treated hydrophilic surface, the Examiner dropped Milne and has asserted, without evidence, that the transparency material in Cheng et al. is hydrophobic. The Examiner has failed to make a proper showing that the transparency in Cheng et al., which is "suitable for in jet printing processes," is hydrophobic. The Examiner has to make this showing before the Applicant is required to rebut it.

Applicant maintains that the term transparency as used in Cheng et al., refers to a coated substrate for receiving an aqueous ink jet ink, not a hydrophobic substrate.

Claim Rejections – 35 U.S.C. § 103

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Patel et al. (U.S. 5,977,210) in view of Miyabayashi et al. (U.S. 2002/0107303).

For the reasons provided above, the disclosure of Patel et al. differs from Applicant's invention by more than just the requirements of a specific type of substrate. Moreover, an obviousness rejection is improper where the proposed modification of the references would destroy the intended function of the references. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose). The use of only an anionic surfactant, a nonionic surfactant or mixtures thereof, would destroy the function of agglomeration sought in Patel et al. Patel et al., as a whole, teaches a method of agglomerating pigments and polymers requiring the use of cationic surfactants to accomplish agglomeration, not a method of providing an image on a hydrophobic surface. Patel et al. fails to teach what, if any, water-soluble surface agents are needed to adhere to hydrophobic surfaces as opposed to other surfaces and what Tg levels to select for the aqueous emulsion polymer for the method of providing an image on a hydrophobic surface. One skilled in the art would not know what formulating ingredients are important for printing on a hydrophobic substrate given the teachings of Patel et al. Moreover, Patel et al. requires the use of cationic surfactants and Applicant excludes cationic surfactants.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng et al. (U.S. 6,239,193) in view of Miyabayashi et al. (U.S. 2002/0107303). Applicant respectfully disagrees.

For the reasons provided above, Cheng et al. differs from Applicant's invention. Cheng et al. does not disclose printing on a hydrophobic substrate. The transparency material disclosed in Cheng et al. is a "transparency material suitable for aqueous ink jet inks or ink jet printing" (col. 15, lines 33-38). Applicant maintains that the term "suitable for aqueous ink jet inks or ink jet printing" means a coated substrate which has been treated to accept an aqueous ink jet ink, as is disclosed by Applicant in its background section. The term transparency as used in Cheng et al., therefore, refers to a coated substrate for receiving an aqueous ink jet ink, not a hydrophobic substrate. Nothing in Miyabayashi et al. cures this deficiency. Moreover, The Examiner must show that the transparency in Cheng et al. is hydrophobic before the Applicant is required to rebut it.

Applicant maintains that such claims are patentable in view of the amendments and arguments presented above. Applicant's attorney thanks the Examiner for the time taken to review this response. In view of the foregoing remarks, Applicant respectfully requests reconsideration of the rejection and allowance of the claims. The Examiner is encouraged to contact the attorney listed below if there are any questions or comments.

Respectfully submitted,



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